

Applicants: Kiran K. Chada et al.
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REMARKS

Claims 1-15, 47, 102, 103 and 116 are pending with claims 4, 6, 7, 10-15, 47, 102, 103 and 116 withdrawn from consideration by the Examiner. Applicants have hereinabove amended claims 1 and 7. Support for the amendments to claim 1 can be found in the specification as originally filed at page 43, line 17 to page 44, line 29 page 5, lines 10-19; page 43, lines 24-36; page 44, lines 4-10. Claim 7 has been amended to correct its dependency in light of claims being cancelled. Applicants have also cancelled claims 2, 3 and 5 herein without disclaimer or prejudice to applicants' right to pursue the subject matter of these claims in the future.

Claims Rejected Under 35 U.S.C. §112, Second Paragraph

The Examiner rejected claims 1-3, 5, 8 and 9 as allegedly indefinite.

In response, applicants respectfully traverse the Examiner's rejection. However, in order to expedite prosecution and without conceding the correctness of the Examiner's position, applicants have hereinabove amended claim 1, from which the remaining rejected claims depend, to more clearly recite the claimed invention. Accordingly, applicants respectfully request reconsideration and withdrawal of this ground of rejection.

Claims Rejected Under 35 U.S.C. §103(a)

Claims 1- 3, 5 and 8

The Examiner rejected claims 1-3, 5, and 8 as allegedly obvious over Soukas et al. (2000) Genes and Development, 14:963-9890, in view of Anand et al. (2000), Nature Genetics, 24:377-380.

In response, applicant respectfully traverses the Examiner's

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rejection. However, in order to expedite prosecution and without conceding the correctness of the Examiner's position, applicants have hereinabove amended the claims to more clearly recite the claimed invention.

Applicants note that prior to applicants' identification of the predominantly preadipocyte composition of the WAT of HMGCI -/- as compared to the predominantly adipocyte composition of the WAT of HMGCI -/- ob/ob mice, there would be no motivation to compare these two specific tissues using differential gene analysis (e.g. see specification at page 5, lines 19 and page 44, lines 4-10). In addition, there would be no reasonable expectation of success that comparing the two tissues would provide such a result because it was not known that the two tissue types differed in their composition, one being primarily preadipocytes and one being primarily adipocytes.

Applicants further note that Soukas et al. in combination with Anand et al. do not teach or suggest the element of differential gene expression in adipocytes versus preadipocytes in the WAT of two different animals. The invention as claimed recites "performing differential gene expression analysis between the WAT of the first animal and the WAT of the second animal wherein the animals are a HMGI-C -/- genotype mouse and a HMGI-C -/- ob/ob genotype mouse." This is not taught by the combination of prior art cited by the Examiner. In addition, one of ordinary skill in the art following the teachings of the prior would not end up determining if a gene is "over-expressed in adipocytes of white adipose tissue (WAT) from a first animal as compared to preadipocytes in WAT from a second animal" (emphasis added).

Accordingly, applicants maintain that the invention as claimed is not obvious over the cited combination of art and therefore

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respectfully requests reconsideration and withdrawal of this ground of rejection.

Claim 9

The Examiner rejected claim 9 as allegedly obvious over Soukas et al. (2000) Genes and Development, 14:963-9890, in view of Anand et al. (2000), Nature Genetics, 24:377-380 and Czech et al. U.S. Patent Application No. 2002/0155472A1.

Applicants note that prior to applicants' identification of the predominantly preadipocyte composition of the WAT of HMGCI -/- as compared to the predominantly adipocyte composition of the WAT of HMGCI -/- ob/ob mice, there would be no motivation to compare these two specific tissues using differential gene analysis (e.g. see specification at page 5, lines 19 and page 44, lines 4-10). In addition, there would be no reasonable expectation of success that comparing the two tissues would provide such a result because it was not known that the two tissue types differed in their composition, one being primarily preadipocytes and one being primarily adipocytes.

Applicants further note that Soukas et al. in combination with Anand et al. and Czech et al. do not teach or suggest the element of differential gene expression in adipocytes versus preadipocytes in the WAT of two different animals. The invention as claimed recites "performing differential gene expression analysis between the WAT of the first animal and the WAT of the second animal wherein the animals are a HMGI-C -/- genotype mouse and a HMGI-C -/- ob/ob genotype mouse." This is not taught by the combination of prior art cited by the Examiner. In addition, one of ordinary skill in the art following the teachings of the prior would not end up determining if a gene is "over-expressed in adipocytes of white adipose tissue (WAT) from a first animal as compared to

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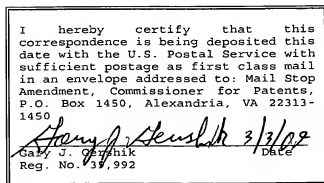
preadipocytes in WAT from a second animal" (emphasis added).

Accordingly, applicants maintain that the invention as claimed is not obvious over the cited combination of art and therefore respectfully requests reconsideration and withdrawal of this ground of rejection.

If a telephone interview would be of assistance in advancing prosecution of the subject application, applicants' undersigned attorney invites the Examiner to telephone him at the number provided below.

No fee, other than the enclosed \$555.00 fee for a three-month extension of time, is deemed necessary in connection with the filing of this Response. However, if any fee is required, authorization is hereby given to charge the amount of any such fee to Deposit Account No. 03-3125

Respectfully submitted,



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